

## REMARKS

In an Office Action dated October 12, 2004, the Examiner rejects all pending claims 1-22 on written description, indefiniteness, and/or prior art grounds. In addition, the Examiner objects to the disclosure and the drawings. In reply, Applicant submits the present reply with Amendment and Remarks. Entry and consideration hereof are respectfully requested. The various points of objection and rejection set forth in the Office Action will now be addressed in turn.

### Objections to the Disclosure

In the Office Action, the Examiner objects to the section heading on page 11 of the application text. The section heading is herein revised to address the Examiner's concern. The Examiner further objects to the presence of claim numbers in the application text. To address the Examiner's concerns, Applicant submits under separate cover a replacement "Summary of the Invention" section pursuant to 37 C.F.R. §1.121(b)(2) in which the claim references are removed from the "Summary" section.

Thus, Applicant herein complies with all of the Examiner's objections to the disclosure; reconsideration and withdrawal thereof are respectfully requested.

### Objections to the Drawings

The drawings are objected to under 37 C.F.R. §1.83(a) as failing to show every feature specified in the claims. First the Examiner contends that the following limitation of claim 9 is not found in the drawings, "face shape of the light valves forms one or more

hexagons”. The Examiner is kindly directed to Figure 3 which shows a sub-area of light valves arranged in hexagonal-type shape. Accordingly, reconsideration and withdrawal of the this objection to the drawings is respectfully requested.

The Examiner further states that the following limitation of claim 12 is not found in the drawings, “a face shape of the light valves is arranged on one or more illumination heads”. However, at least Figures 4 and 5 show light valves arranged on an illumination unit for performing a scanning movement. See, e.g., page 13, second complete paragraph. Accordingly, reconsideration and withdrawal of the this objection to the drawings is respectfully requested.

Finally, the Examiner states that the following limitation of claim 13 is not evident in the drawings, “the illumination head comprises a rod movable relative to the illumination face...” Claim 13 is herein amended to address the Examiner’s concern. Accordingly, reconsideration and withdrawal of the this objection to the drawings is respectfully requested.

#### Claim Rejections Under 35 U.S.C. §112

Claims 12, 13, and 18 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement because certain claimed subject matter is allegedly not described in the specification in such a way as to convey to one skilled in the art that Applicant was in possession of the claimed invention at the time the present application was filed.

In determining compliance with the written description requirement of §112, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991). The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. MPEP §2163.02.

With regard to claim 12, the Examiner takes issue with the limitation “a face shape of the light valves arranged on one or more illumination heads”. Support for this limitation is found at least at page 8, last paragraph. Also, light valves arranged as “illumination units” are shown in Figure 4 and described at page 13, second complete paragraph. Applicant notes that the subject matter of the claim need not be described literally (i.e.,

using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. MPEP §2163.02. Further, Applicant notes that the standard for determining compliance with the written description requirements of §112, first paragraph, is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*. Applicant respectfully submits that, from the description provided, one of skill in art could appreciate that at the time the application was filed, Applicant was in possession of “a face shape of the light valves arranged on one or more illumination heads”.

With regard to claim 13, the Examiner takes issue with the limitation, “each illumination head and the illumination face being adapted to perform a relative movement across an illumination area”. Here again, support is found at least at page 9, first paragraph. Additionally, scanning arrangements employing the light valves of the invention are described in the application with reference to Figures 4 and 5. See, e.g., page 13, second full paragraph through page 17, last paragraph. This description adequately conveys to one of skill in the art that, at the time the application was filed, Applicant clearly was in possession of the above-quoted claim limitation.

Finally, with regard to claim 18, the Examiner takes issue with the limitation, “the light guides of the illumination unit are so arranged with respect to the light valve arrangement that the optical energy fed to a subset of light valves does not differ significantly from each other when the subsets of light valves illuminate adjacent areas or areas close to each other on the illumination face”. Support for this limitation is found at

page 10, first paragraph. Further, this feature is distinguished over the prior art arrangements discussed at page 1, third paragraph. Clearly, this description adequately conveys to one of skill in the art that, at the time the application was filed, Applicant was in possession of the above-quoted claim limitation.

Accordingly, claims 12, 13, and 18 satisfy the provisions of 35 U.S.C. §112, first paragraph. Reconsideration and withdrawal of the relevant outstanding rejections is respectfully requested.

Claims 12 and 13 are further rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

In reviewing a claim for compliance with 35 U.S.C. §112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. §112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001). If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. §112, second paragraph, would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993).

Concerning claim 12, the Examiner takes issue with the limitations, “a face shape of the light valves arranged on one or more illumination heads” and “each illumination head...adapted to perform a relative movement across an illumination area”. The Examiner is respectfully directed to page 13, second complete paragraph, where light valves are described as being arranged for cooperating with illumination units for performing a scanning movement. Also, a scanning movement is described with respect to Figure 5 at page 15, first complete paragraph. Based on the claim language and this description provided in the specification, one of skill in the art could certainly interpret the metes and bounds of claim 12 so as to understand how to avoid infringement. Thus, the provisions of §112, second paragraph, are satisfied; reconsideration and withdrawal of the relevant rejection is requested.

Claim 13 is rejected under §112, second paragraph, due to antecedent basis issues. Claim 13 is herein amended so as to depend from claim 12. Thus, the antecedent basis concerns of the Examiner are herein resolved; reconsideration and withdrawal of the relevant rejection is requested.

Accordingly, the claims satisfy all of the provisions of 35 U.S.C. §112.

#### Claim Rejections Under 35 U.S.C. §102

Claims 1, 3-5, 8, 14, 15, and 18-20 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,838,865 to Gulick. Applicant herein antedates the Gulick reference, thus the rejection is traversed and must be withdrawn.

The Gulick patent granted on November 17, 1998 from an application originally filed in the USPTO on June 05, 1997.

The present application was filed under 35 U.S.C. §371 as the U.S. national stage of International Patent Application No. PCT/DK98/00154. Thus, the effective U.S. filing date of the present application is April 14, 1998 (i.e., the international filing date of the PCT application). See, e.g., MPEP §1893.03(b).

The present application claims priority under 35 U.S.C. §119(a) to Danish Patent Application No. 0415/97 filed on April 14, 1997 and Danish Patent Application No. 0063/98 filed on January 16, 1998. The “Combined Declaration and Power of Attorney” document filed in the USPTO along with the national stage papers on October 12, 1999 included a proper claim for priority under 35 U.S.C. §119(a) to the two above-mentioned Danish patent applications. The “Notification of Acceptance of Application” issued by the USPTO on December 08, 1999 acknowledged the Office’s receipt of the “Combined Declaration and Power of Attorney” and of certified copies of the two priority applications transferred from the International Bureau. The Examiner further acknowledges receipt of the certified copies of the priority documents in the Office Action dated January 30, 2002. Applicant provides herewith English translations of the priority Danish Patent Application Nos. 0415/97 and 0063/98. Thus, the claims for priority are herein perfected. See 37 C.F.R. §1.55 and MPEP §201.13.

The Danish priority Application No. 0415/97 was filed on April 14, 1997. The Gulick application was filed on June 05, 1997. The Danish Application No. 0415/97

provides description of the invention as presently recited in claims 1-22 in compliance with the requirements of 35 U.S.C. §112. Accordingly, the Gulick reference is herein antedated. Withdrawal of the relevant novelty rejections of claims 1, 3-5, 8, 14, 15, and 18-20 is respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

Claim 6 is rejected under 35 U.S.C. §103(a) as being obvious over the Gulick reference. As discussed, immediately above, Gulick is herein antedated. Thus, the present obviousness rejection of claim 6 is traversed; reconsideration and withdrawal thereof is respectfully requested.

Claim 7 is rejected under 35 U.S.C. §103(a) as being obvious over Gulick in view of U.S. Patent No. 6,249,381 to Suganuma. Gulick is herein antedated, as discussed above. Moreover, the Suganuma patent granted on June 19, 2001 on an application filed in the USPTO on April 23, 1999. As mentioned above, the effective U.S. filing date of the present application is April 14, 1998 (i.e., the international filing date of PCT/DK98/00154). That is, Suganuma was filed and patented *after* the filing date of the present application. Thus, the Suganuma reference does not qualify as prior art with respect to the present application. Accordingly, for at least these reasons, the present §103 rejection of claim 7 must be withdrawn.

Claims 2, 9-11, 21, and 22 are rejected under 35 U.S.C. §103(a) as being obvious over Gulick in view of U.S. Patent No. 6,678,023 to Yamazaki. Gulick is herein antedated, as discussed above. Moreover, the Yamazaki patent granted on January 13,



2004 from an application filed on August 03, 2000 which was a divisional of U.S. Application No. 09/210,777 filed on December 15, 1998 (now, U.S. 6,144,426). That is, the earliest effective filing date of Yamazaki is December 15, 1998. As mentioned above, the effective U.S. filing date of the present application is April 14, 1998 (i.e., the international filing date of PCT/DK98/00154). That is, Yamazaki was filed and patented *after* the filing date of the present application. Thus, the Yamazaki reference does not qualify as prior art with respect to the present application. Accordingly, for at least these reasons, the present §103 rejection of claims 2, 9-11, 21, and 22 must be withdrawn.

Claims 16 and 17 are rejected under 35 U.S.C. §103(a) as being obvious over Gulick in view of U.S. Patent No. 3,553,364 to Lee. Gulick is herein antedated, as discussed above. Lee, singularly, does not teach or suggest all of the limitations of claims 16 and 17 and thus the present rejection must be withdrawn. Moreover, claims 16 and 17 variously depend from allowable claim 1 and are thus correspondingly allowable. For at least these reasons, reconsideration and withdrawal of the §103 rejection of claims 16 and 17 is respectfully requested.

Conclusion

The present application satisfies all requirements of 35 U.S.C. §112 and 37 C.F.R. §1.83 and the claims are novel and non-obvious over the cited references. Accordingly, withdrawal of all objections and rejections and prompt issuance of a Notice of Allowance is gratefully requested.


The Examiner is invited to contact Applicant's attorneys at the below-indicated telephone number regarding this Reply or otherwise concerning the present application.

Applicant hereby petitions for any necessary extension of time required for consideration and entry of the present Reply.

Please charge any required fees for this Reply, or otherwise concerning the present application, to Deposit Account No. 06-1130 maintained by Applicant's attorney.

Respectfully submitted,  
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